

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Herbert Bächler, et al.
Appln. No. : 09/610,284
Filed : July 6, 2000
Title : HEARING DEVICE HAVING SELF-CONTAINED, SELF-IDENTIFYING
PERIPHERAL HARDWARE UNITS

Conf. No. : 5343
Art Unit : 2615
Examiner : Phylesha L. Dabney

Customer No. : 00116
Docket No. : 32794US1

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection in the above-identified application pursuant to 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and 1303 Off. Gaz. Pat. Office 21 (February 7, 2006).

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal pursuant to 37 CFR § 41.31(a)(1), accompanied by the requisite fee of \$500.00 under 37 CFR § 41.20(b)(1).

The review is requested for the reasons stated on the following sheets.

The three-month period for responding to the Final Office Action expired on November 23, 2006. A two-month extension of time was previously requested and paid for. Accordingly, Applicants request and petition that the response date be extended for one additional month, up to and including, February 23, 2007. The additional \$570.00 extension of time fee (\$1,020 less the \$450 already paid) is being charged to Deposit Account No. 16-0820, Order No. 32794US1.

REASONS FOR REQUEST

1. Background

Claims 12–27 were rejected under 35 U.S.C. 103(a) over “IEEE 1451: A standard in Support of Smart Transducer Networking,” (hereinafter “IEEE 1451”).

2. Availability of Cited Reference as Prior Art Under 35 U.S.C. 102/103

The IEEE 1451 reference is dated May 2000 (see header on page 526; see also "Notice of References Cited," page 2, Mail Date 20051130), which is subsequent to the international filing date of the instant application of November 24, 1998. Therefore, the cited reference is not available as prior art under any of the subsections of 35 U.S.C. 102, and cannot properly be cited as the basis of a rejection under 35 U.S.C. 103(a).

In response, the Examiner has stated that the rejection is proper since the IEEE 1451 reference is not cited by the Examiner as prior art in itself. Rather, citing MPEP § 2124, the Examiner states that the IEEE 1451 reference is being cited to show what the state of the art was at the time the invention was made. Specifically, the Examiner explains that the IEEE 1451 reference makes reference to the actual IEEE 1451.2 standard (hereinafter “1451.2 Standard”), which was apparently published on September 26, 1997.

First, Applicants submit that this reasoning is not proper since, it relies upon speculation as to what the 1451.2 Standard actually teaches. The cited IEEE 1451 reference does not contain any quotation or other excerpt from the publication of the 1451.2 Standard. If it is the teachings of the 1451.2 Standard that Examiner is relying upon to conclude that the instant claims are obvious, then a publication of the 1451.2 Standard itself, having a publication date that antedates the present application, should have been cited. Presently, there is no basis in the

record for determining whether the teachings relied upon by the Examiner actually existed in the 1451.2 Standard as published prior to the present invention.

Second, MPEP § 2124 relates to instances where a factual reference is used to show a universal fact, such as properties of a material or a scientific truism. The IEEE 1451 reference is being cited by the Examiner in an attempt to show the contents of an earlier publication, not a universal fact. The principle set forth in MPEP § 2124 clearly does not apply to the instant case.

3. Examiner's Omissions of Elements Needed for a *Prima Facie* Rejection

a) Omission of Elements of Claim 12

Claim 12 requires “a comparing unit” having one input operationally connected to an “identification unit” in a peripheral self-contained hardware unit and another input connected a “storage unit” containing identification information of more than one hardware peripheral unit. The IEEE 1451 does not disclose any such comparing unit.

The Examiner asserts that the IEEE 1451 reference teaches the claimed comparing unit since it describes the disclosed system as “plug and play,” which the Examiner contends would inherently comprise a comparing unit. Considering the entire system described by the IEEE 1451 reference, there would be no logical reason to include a comparing unit as presently claimed. The Examiner cites the “TEDS” of the IEEE 1451 reference as teaching the identification unit of claim 12. As explained on p. 526 of the IEEE 1451 reference, the TEDS is an electronic data sheet that is stored in memory provided on the transducer. As described, the transducer can be connected to a microprocessor, allowing the microprocessor to access the

TEDS and read the electronic data sheet. Thus, the use of TEDS allows for “self-description” of transducers connected to a network.

By contrast, the present application describes peripheral hardware units (3) that contain identifying information *without* any description or configuration information. The configuration information for many different peripherals is stored separately in a storage unit (read-only memory 11) as a sort of “library.” Thus, a comparing unit (9) is employed to compare the currently connected peripheral hardware unit (3) to the stored information in the “library” in order to locate and retrieve the corresponding configuration information. Since the TEDS in the IEEE 1451 reference already contains the electronic data sheet, there is no need for the claimed “comparing unit.” That is, according to IEEE 1451, a microprocessor *directly* obtains the TEDS (i.e. configuration information” from the connected transducer, without requiring any comparison with a stored library of data sheets.

The Examiner has failed to show that each and every limitation of claim 12 is taught or suggested by the IEEE 1451 reference, as required to support a rejection under 35 U.S.C. 103(a). The rejection of dependent claims 13–23 is deficient for the same reasons as claim 15, from which they each depend.

b) Omission of Elements of Claim 24

Claim 24 recites “a method for manufacturing a hearing device,” including a step of “storing the current hardware configuration of the *hearing device*.” The IEEE 1451 reference relates to the use of smart transducers, including sensors and actuators. Applicants respectfully submit that the IEEE 1451 reference does not teach or suggest a hearing device. More particularly, the IEEE 1451 reference is not related to the manufacturing of a hearing device, as

specifically claimed. Most notably, the Examiner's rejection does not specifically address these limitations or even state what disclosure of IEEE 1451 is being relied upon for disclosing or suggesting a hearing device.

For at least this reason, the Examiner has failed to show that each and every limitation of claim 24 is taught or suggested by the IEEE 1451 reference, as required to support a rejection under 35 U.S.C. 103(a). The rejection of dependent claims 25–27 is deficient for the same reasons as claim 24, from which they each depend.

3. Conclusion

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, Applicants request notification setting a date for filing an appeal brief.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. 32794US1.

Respectfully submitted,
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